



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.

(hereinafter "Rochberger"), claim 17 as being unpatentable over Teodosiu and Borella as applied to claim 1 above, and further in view of Microsoft Dictionary 4th edition (hereinafter "Microsoft"). The Examiner rejected claims 25-38 based on the same rationale as claims 1-24, claims 39-49 based on the same rationale as claims 1-24, claims 50-56 based on the same rationale as claims 1-18, claims 57-78 based on the same rationale as claims 1-24, claims 79-93 based on the same rationale as claims 1-24, claims 94-99 based on the same rationale as claims 1-24, claims 100-109 based on the same rationale as claims 1-24, and claims 110-111 based on the same rationale as claims 1-24. Applicants respectfully traverse these rejections and submit that the Examiner has clearly failed to present a *prima facie* rejection of Applicants' independent claims.

First, the rejection is improper because Teodosiu is not a prior art reference. More specifically, Teodosiu is a published U.S. patent application that was filed on Sep. 13, 2001, after Applicants' priority date of Jan. 22, 2001. Teodosiu does claim the benefit of two provisional applications both filed Nov. 22, 2000. However, the Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and the provisional application. A review of Teodosiu's two provisional applications shows that they vary greatly from Teodosiu's published utility application. The subject matter on which the Examiner is relying on to reject Applicants' claims does not appear to be entirely present in one of Teodosiu's provisional applications. Therefore, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

Specifically, the Examiner has not shown that every portion of Teodosiu relied upon by the Examiner to reject Applicants' claims is found in the same one of Teodosiu's provisional applications. It is the Examiner who has the burden of proof to establish that a reference qualifies as prior art. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). In the Final Action the Examiner did nothing more than make conclusory statements in regard to this issue. Such conclusory statements are insufficient to meet the required burden of proof to establish a reference as prior art. In fact, it is clear that most of the portions of Teodosiu used by the Examiner in rejecting the claims are not found in either of Teodosiu's provisional applications. **A comparison between Teodosiu's published application and each provisional application clearly shows that the teachings relied on by the Examiner are largely missing from Teodosiu's provisional applications.**

For example, in the rejection of claims 1-5, 8-16 and 18-24, the Examiner relies on the following paragraphs of Teodosiu: [0008], [0010], [0029], [0031], [0032], [0038-0040], [0044 - 0057] and [0072 - 0077]. None of these paragraphs are found in either of Teodosiu's provisional applications. The Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and a single one of the provisional applications. See, *In re Wertheim*, 209 USPQ 554 (CCPA 1981). **Since the portions of Teodosiu relied upon by the Examiner to reject the claims are not common to both Teodosiu's published application and one of Teodosiu's provisional applications, the rejection is improper.**

In the Response to Arguments section of the current Action, the Examiner states that "Under U.S.C. 112, it does not mention[] that the provisional application and the utility application have to be the same length or exactly the same word by word with the utility application." Applicants have never argued that 35 U.S.C. § 112 requires that the provisional application and the utility application have to be the same length or exactly the same word by word with the utility application. However, the law does require that a filing date of a parent application be used as a 35 U.S.C. § 103(a) prior art date for a child application only for subject matter that is common to both applications. The fact that only "common subject matter" can be used as prior art is both common sense and well-settled law. See, *In re Wertheim*, 209 USPQ 554 (CCPA 1981).

Moreover, Teodosiu's published application is not entitled to the Nov. 22, 2000 date as a section 103(a) prior art date unless at least one claim of Teodosiu's published application is supported (under 35 U.S.C. § 112) in the provisional application. Under 35 U.S.C. 119(e)(1), a published utility application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application. Since both of Teodosiu's provisional applications are much shorter informal papers as compared to Teodosiu's utility application, it is not at all clear that either one of Teodosiu's provisional applications provide full 35 U.S.C. § 112 support for any of the claims of Teodosiu's published utility application. The rejection is improper unless the Examiner can show that Teodosiu's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 103(a) prior art date. See also M.P.E.P. § 2136.03(IV).

In response to this argument, the Examiner states that pages 2-6 of Teodosiu's provisional application no. 60/252,658 teach the limitations of claim 1 of Teodosiu's published application. However, a careful review of pages 2-6 of Teodosiu's provisional application no. 60/252,658 fails to reveal that this portion of Teodosiu's provisional application satisfies the written description and enablement requirements of 35 U.S.C. § 112 for claim 1 of Teodosiu's published application. Claim 1 of Teodosiu's published application recites:

1. A method comprising:
 - receiving a peer resource request at a resource naming service (RNS) server, said peer resource request being received from a peer platform through a networking environment;
 - generating a peer resource response based on the peer resource request; and
 - returning the peer resource response to the peer platform through the networking environment, said peer resource response to enable the peer platform to access a peer resource corresponding to the peer resource request within the networking environment.

Pages 2-6 of Teodosiu's provisional application no. 60/252,658 do not describe the RNS server "receiving a peer resource request ... from a peer platform through a networking environment". Nor do pages 2-6 of Teodosiu's provisional application no. 60/252,658 describe "generating a peer resource response based on the peer resource request". Nor do pages 2-6 of Teodosiu's provisional application no. 60/252,658 describe "returning the peer resource response to the peer platform through the networking environment, said peer resource response to enable the peer platform to access a peer resource corresponding to the peer resource request within the networking environment." **Since the Examiner has not shown that Teodosiu's provisional application satisfies the written description and enablement requirements for any claim of Teodosiu's published application, the rejection is improper.** *See*, M.P.E.P. § 2136.03(IV).

The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). Since the Examiner has not proven that both of the above requirements have been met for Teodosiu's teachings to qualify as prior art, the Examiner has not met this burden of proof and the rejection is improper.

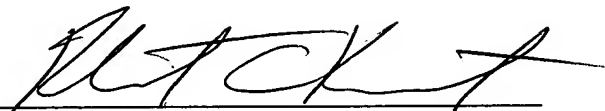
The Examiner's rejection of many of the dependent claims is additionally erroneous. For example, the cited art is clearly insufficient to support the rejection of claim 2, as discussed in detail in Applicants' previous response on pp. 29-30.

In light of the foregoing remarks, Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5681-06900/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Appeal

Respectfully submitted,



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